

Claims 1 and 7-17 are pending in the present application. Claim 1 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Shibuta et al. (US Patent 5,512,867). Claims 7-11 and 14-17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Shibuta in view of Ghorashi et al. (US Patent 5,202,187). The Examiner has indicated that claims 12 and 13 contain allowable subject matter and would be allowed if rewritten in independent form.

Applicant submits the following in traversal of the rejections.

Rejection of claim 1 under § 102(b) as being anticipated by Shibuta

Claim 1 describes an *electromagnetic device body* including a coil formed with a conductor wound around a bobbin.

The Examiner has not established where an electromagnetic device body is taught in the prior art. For at least this reason, claim 1 should be deemed patentable or the finality of the present Office Action should be withdrawn.

In the previous Amendment, Applicant indicated that the Examiner has not established where the prior art teaches that the cover member protects the coil from being directly subjected to molding pressure when the cover is formed by injection molding, by covering the coil.

In response to Applicants' arguments, the Examiner states that a recitation of an intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the Examiner states that epoxy adhesive 4 covers the super conductive wire, thereby protecting it from being directly subjected to molding pressure.

However, terminology which limits the structure of the invention must be treated as claim limitations. *Corning Glass Works v. Sumimoto Elec. U.S.A. Inc.*, 868 F.2d 1251, 1257 (Fed Cir. 1989). The subject claim language describes that the *cover member* protects the *coil* from being directly subjected to molding pressure when the cover is formed by injection molding by covering the coil. Since the terminology limits the structure of the invention, consideration must be given to these aspects of the claims.

Furthermore, epoxy adhesive 4 is used to fix the superconducting wire to the container and reduces mechanical strain. There is no indication that molding pressure would be applied to the superconducting wire of Shibuta. The Examiner's reasoning appears to merely be a result of hindsight.

The Examiner also states that Applicant does not describe the limitation of injection molding the cover. The claim states that the "cover is formed by injection molding". Therefore, it appears clear that the claim describes that the cover be formed by injection molding.

For the above reasons, claim 1 and its dependent claims should be deemed patentable.

*Rejection of claims 7-11 and 14-17 under § 103(a) as being unpatentable
over Shibuta in view of Ghorashi*

Claim 7

In the previous Amendment, Applicant indicated that Ghorashi teaches away from Shibuta. In response, the Examiner states that Ghorashi teaches that the products prepared by melt coating a resin on magnet copper wire have often had deficiencies such as water crazing, marginal polymer flexibility and poor stability in high temperatures. Therefore, Ghorashi teaches a process which yields a coated copper wire having an adherent coating which is resistant to water crazing and is stable at high temperatures.

As Applicant indicated in the previous amendment, since resin results in water crazing and poor stability, Ghorashi teaches a process which does not use resin. On the contrary, Shibuta teaches the use of resin. Col. 1, lines 52-54. Therefore, the combination is not obvious because the references teach away from each other.

The Examiner also states that Shibuta teaches that the conductor has an outer coating, however, the Examiner has not established where an outer coating is taught in Shibuta.

For the above reasons, claim 7 and its dependent claims should be deemed patentable. Since claims 8, 14 and 15 describe similar elements, they are patentable for the same reasons.

Claims 9-11 and 16

In rejecting claims 9-11 and 16, the Examiner states that an electromagnet of this design is useful in many devices and that the specific environment in which the electromagnet is used is a *design choice* based on the user's requirements.

However, merely stating that an element is mere design choice is insufficient to establish an obviousness rejection.

The use of per se rules, while undoubtedly less laborious than a searching comparison of the claimed invention -- including all its limitations -- with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. Per se rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on per se rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to Graham and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any per se rules of obviousness.... *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995).

Furthermore, there is no indication of a motor (claim 9), a transmission control valve (claim 10), a case containing oil (claim 11) and a pair of coils opposing each other (claim 16), in the cited prior art. Therefore, claims 9-11 and 16 are not obvious and should be deemed patentable.

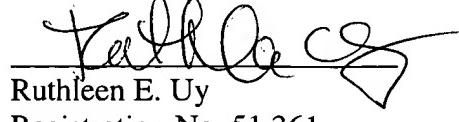
Claim 17

With respect to claim 17, the Examiner states that Fig. 1 discloses a cover member that is cylindrical. It appears the Examiner is referring to epoxy based adhesive 4 which was previously cited for teaching the cover member of claim 1. However, upon viewing the epoxy based adhesive 4 in Fig. 1, it is apparent to one of ordinary skill in the art that epoxy based adhesive 4 is not cylindrical. Therefore, claim 17 should be deemed patentable.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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